

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
WESTERN DIVISION

HARVINDER S. SANDHU, M.D., and)	
KYPHON INC.,)	
)	
Plaintiffs,)	
)	
v.)	No. 05-2863 JPM/dkv
)	
MEDTRONIC SOFAMOR DANEK, INC.,)	
MEDTRONIC SOFAMOR DANEK USA,)	
INC., and SDGI HOLDINGS, INC.,)	
)	
Defendants.)	

ORDER GRANTING KYPHON'S MOTION TO EXCLUDE THE TESTIMONY OF
WILLIAM R. KENNEDY, M.D. IN CONNECTION WITH THE PRELIMINARY
INJUNCTION HEARING (DOC. 211); ORDER GRANTING DEFENDANTS' MOTION
TO RECONSIDER EXCLUSION OF THE TESTIMONY OF DR. WILLIAM R.
KENNEDY (DOC. 279)

Before the Court are Kyphon's Motion to Exclude the
Testimony of William R. Kennedy, M.D. in Connection with the
Preliminary Injunction Hearing (Doc. 211), filed November 13,
2006, and Defendants' Motion to Reconsider Exclusion of the
Testimony of Dr. William R. Kennedy (Doc. 279), filed December
11, 2006. Defendants' Opposition to Kyphon's Motion to Exclude
the Testimony of William R. Kennedy, M.D. in Connection with the
Preliminary Injunction Hearing (Doc. 249) was filed on November
15, 2006. No opposition was filed in response to Defendants'
Motion to Reconsider.

According to Plaintiff Kyphon, Inc. ("Kyphon"), the
testimony of Dr. William R. Kennedy ("Dr. Kennedy") should be

excluded because, under the law, invalidity of a patent is based on what a written disclosure of a reference conveys to a person of ordinary skill in the art. Because Dr. Kennedy is the author of a prior art reference, his testimony, which cannot be used to *expand* upon what the reference discloses to a person of ordinary skill, is irrelevant to whether the '404 patent is valid.

(Kyphon's Motion to Exclude the Testimony of William R. Kennedy, M.D. in Connection with the Preliminary Injunction Hearing ("Kyphon's Motion"), Nov. 13, 2006, Doc. 211, 1-2.)

In their opposition, Defendants assert that the Federal Circuit has permitted the use of extrinsic evidence, including author testimony, to explain the meaning of a reference. According to Defendants, Dr. Kennedy is not attempting to expand upon what his reference discloses or testify with respect to questions of invalidity, but rather explain what a person of ordinary skill in the art would have understood when reading his reference. Defendants also state that excluding Dr. Kennedy's testimony would unfairly prejudice Defendants by denying Dr. Kennedy the opportunity to explain to the Court the meaning of his reference. (Defendants' Opposition to Kyphon's Motion to Exclude the Testimony of William R. Kennedy, M.D. in Connection with the Preliminary Injunction Hearing, Nov. 15, 2006, Doc. 249, 1-4(citing In re Baxter Travenol Labs., 952 F.2d 388, 390-91 (Fed. Cir. 1991)(finding testimony by the author proper when it

"merely explained what he meant when using [a] phrase [found in his reference]"'))).)

Kyphon's Motion was orally GRANTED during the preliminary injunction proceedings on November 20, 2006. Subsequently, Defendants' Motion to Reconsider Exclusion of the Testimony of Dr. William R. Kennedy was filed, requesting that the Court reconsider its decision to exclude Dr. Kennedy's testimony because Dr. Kennedy's testimony at the preliminary injunction hearing was limited to explaining to the Court what a person of ordinary skill in the art would understand his reference to mean. (Defendants' Motion to Reconsider Exclusion of the Testimony of Dr. William R. Kennedy ("Defendants' Motion to Reconsider"), Dec. 11, 2006, Doc. 279-1, 1-9.)

The Court finds that for the reason asserted in their brief, Defendants' Motion to Reconsider should be, and is hereby, GRANTED. The testimony of Dr. Kennedy offered by Defendants at the preliminary injunction hearing is hereby accepted and admitted into evidence.

So ORDERED this 16th day of July, 2007.

/s/ Jon P. McCalla
JON P. McCALLA
UNITED STATES DISTRICT JUDGE